



2876
Lhw

IN THE UNITED STATES OF AMERICA
PATENT AND TRADEMARK OFFICE

Applicant: Peter W. Fajkowski

Attorney Doc. #: 18121/100233-07

Serial No.: 09/297,532

Examiner: Daniel St. Cyr

Filed: June 28, 1999

Art Unit: 2876

For: Method and Apparatus for Coupon Management and Redemption

Mail Stop AMENDMENT

Commissioner of Patents

P.O. Box 1450

Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION

In the Office Action dated 08/23/04, the Examiner rejected claim 55 as not being enabled and claims 54 and 55 as obvious over U.S. Patent 5,424,524 to Ruppert in view of U.S. Patent 5,420,606 to Begum. For the reasons which follow, applicant respectfully suggests that the rejections are clearly improper and should be withdrawn.

I. Lack of Enablement of Claim 55.

The Examiner believed that claim 55's limitation of a "pager frequency" was not described sufficiently in the specification to enable one skilled in the art to make or use the claimed invention. However, applicant submits that the rejection is clearly contrary to MPEP §2164.01 which sets forth the test for enablement. That section provides in part:

The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. A patent need not teach, and preferably omits, what is well known in the art.